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REMARKS

Claims 1 through 10 are pending in this application.

Claim Rejection under 37 C.F.R. § 103

Claims 1 through 8 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Miichi U.S. Patent No. 5,880,745 in view of Kitou *et al.* U.S. Patent No. 5,870,073.

Claims 1 and 3 have been amended to recite as a positive limitation of the claimed subject matter that no ADC or PLL are utilized for signal conversion. As the specification (p. 2, lines 11-18) explains, these features of prior art devices cause considerable increase of production cost, as well as signal loss and jittering, making signal conversion unstable. The cited art does not teach or suggest a technique for providing signal conversion without use of an ADC or PLL.

The Miichi device utilizes an ADC 36 and a PLL 40 for signal conversion. The Kitou device utilizes ADC 201 and PLL 205. Therefore, the cited references do not satisfy all of the limitations and characteristics of the claimed subject matter, as now amended. Accordingly, Miichi and Kitou do not make Jun's invention obvious.

In addition, the following points are further noted for the record, although they are made moot by the aforesaid amendment expressly negating ADCs and PLLs. First, Miichi and Kitou are combined as references without citing anything in the prior art that teaches, suggests, or motivates the specific combination of references to accomplish the specific purposes of Jun's invention.

Before the PTO may combine the disclosures of two or more prior art

references in order to establish *prima facie* obviousness, there must be some suggestion for doing so, found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999)(teaching or motivation or suggestion to combine is an “essential evidentiary component of an obviousness holding”); *In re Rouffet*, 149 F.3d 1350, 1355, 47 U.S.P.Q.2d 1453 (Fed. Cir. 1998; *In re Chu*, 66 F.3d 292 (Fed. Cir. 1995); *Heidelberger Druckmaschinen AG v. Hantscho Commercial Prods., Inc.*, 21 F.3d 1068, 1072 (Fed. Cir. 1994)(“When the patented invention is made by combining known components to achieve a new system, the prior art must provide a suggestion or motivation to make such a combination.”); *In re Jones*, 958 F.2d 347, 351, 21 U.S.P.Q.2d 1941, 1943–44 (Fed. Cir. 1992); *In re Fine*, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1586, 1589–90 (Fed. Cir. 1988); *In re Geiger*, 815 F.2d 686, 688 (Fed. Cir. 1987); *ACS Hosp. Sys., Inc. v. Montefiore Hosp.*, 732 F.2d 1572, 1577, 221 U.S.P.Q.2d 929, 933 (Fed. Cir. 1984).

“Combining prior art references without evidence of such a suggestion, teaching, or motivation simply takes the inventor's disclosure as a blueprint for piecing together the prior art to defeat patentability.” Doing that is “the essence of hindsight.” *In re Dembiczak*, 175 F.3d 994, 999, 50 U.S.P.Q.2d 1614 (Fed. Cir. 1999). The showing must be “clear and particular.” Broad conclusory statements standing alone are not legally sufficient. *Id.* There must be “particular findings regarding the locus of the suggestion, teaching, or motivation to combine the prior art references.” *Id.* at 1000. The PTO must explain, as it did not do here, what specific

understanding or technical principle would have suggested the combination of references. *Id.*; *In re Rouffet*, 149 F.3d 1350, 1357, 47 U.S.P.Q.2d 1453, 1459 (Fed. Cir. 1998).

Second, the rejection is based on what “would have been obvious to one of ordinary skill in the prior art” (p. 2). Yet, the rejection contains no findings on the ordinary level of skill in the pertinent art. Also, the record lacks substantial evidence to support any such findings. Further, the pertinent art is not identified.

In *In re Dembiczak*, 175 F.3d 994, 50 USPQ2d 1614 (Fed. Cir. 1999), the Federal Circuit overturned an obviousness rejection by the Board because of its failure to make the kind of obviousness legal analysis commanded in *Graham v. John Deere Co.*, 376 U.S. 1, 17-18 (1966). Such a legal analysis must begin with making specific findings of fact regarding the level of ordinary skill in the art. See also *In re Mayne*, 104 F.3d 1339, 1341, 41 USPQ2d 1451, 1453 (Fed. Cir. 1997); *In re Huang*, 100 F.3d 135, 138, 40 USPQ2d 1685, 1688 (Fed. Cir. 1996). The Federal Circuit said in *Dembiczak* (175 F.3d at 1000-01, 50 USPQ2d at 1618):

The Commissioner of Patents and Trademarks (“Commissioner”) attempts to justify the Board's decision on grounds different from that relied upon by the Board, arguing that one of ordinary skill in the art would have been motivated to combine the references. Of course, in order to do so, the Commissioner must do what the Board did not do below: make specific findings of fact regarding the level of skill in the art (“a designer and manufacturer of trash and leaf bags, particularly one specializing in the ornamental and graphic design of such bags”)

See also *In re Kaplan*, 789 F.2d 1574, 1580, 229 USPQ 678, 683 (Fed. Cir. 1986)

("Even if obviousness of the variation is predicated on the level of skill in the art, prior art evidence is needed to show what that level of skill was."). Thus, this office action lacks evidence and findings that the Federal Circuit considers essential to support a rejection.

Finally, it is noted that "adapted for" is a positive claim limitation. *In re Venezia*, 530 F.2d 956, 189 U.S.P.Q. 149, 151-52 (CCPA 1976); *Pac-Tec, Inc. v. Amerace Corp.*, 903 F.2d 796, 801, 14 U.S.P.Q.2D 1871, 1876 (Fed. Cir. 1990).

New Claims

New claims 9 and 10 correspond generally to claim 1, but claims 9 and 10 are written in Jepson format and also in a format invoking § 112, par. 6. Accordingly, they incorporate by reference the corresponding structures and acts described in the specification for performing the recited functions. The latter structures and acts provide a referent for the functional language of claims 9-10, whereby the specification acts as a glossary for the claim language. *Chuiminatta Concrete Concepts, Inc. v. Cardinal Industries, Inc.* 145 F.3d 1303, 1308, 46 USPQ2d 1752 (Fed. Cir. 1998)

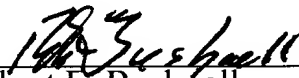
In view of the above, it is submitted that the claims of this application are in condition for allowance, and early issuance thereof is solicited. Should any questions remain unresolved, the Examiner is requested to telephone Applicant's attorney.



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A fee of \$80.00 is incurred by the addition of one (1) independent claim in excess of 3. Applicant's check drawn to the order of Commissioner accompanies this Response. Should the check become lost, should other fees be incurred, the Commissioner is authorized to charge Deposit Account No. 02-4943 of Applicant's undersigned attorney in the amount of such fees.

Respectfully submitted,


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